

RESPONSE UNDER 37 C.F.R. §1.116
US APPLICATION NO. 09/913,885
ATTORNEY DOCKET NO. Q65570

REMARKS

General remarks.

Claims 1-16 are all the claims pending in the application. Applicant thanks the Examiner for acknowledging the claim to priority under 35 U.S.C. § 119. Applicant thanks the Examiner for giving required consideration to the foreign-language references in the IDS files on 8/01 and 11/01.

Claim rejections -- 35 U.S.C. § 102

The Examiner rejected claims 1-2, 4-5, 7-8, 10-11, 13, 14, and 16 under 35 U.S.C. § 102(e) as being anticipated by Willhof. Applicant respectfully traverses this rejection, first with respect to independent claim 1, at least in view of its requirement for:

terminating the setting up of the call
channel once the user message has been
communicated

In making this rejection, the Examiner essentially advances the same arguments as in the preceding office action mailed December 30, 2004 -- that this requirement is met by Willhof by the teachings at col. 7, lines 30-33.

Applicant draws the Examiner's attention to the context of these Willhof teachings. In Willhof, an Origination message is sent to set up the call. This message instructs the BMI that a SMS transmission is forthcoming and that neither the vocoder or data modem should be used. After sending this Origination message, the mobile station proceeds as with any other call. The

mobile station requests the assignment of a digital traffic channel. The mobile station then waits for the BMI to assign the digital traffic channel. Once the digital traffic channel is assigned, the mobile station switches to the assigned digital traffic channel. At this point, the call is set up and transmission may commence. *Only after a channel is assigned and switched to does the mobile station transmit the SMS message.* After transmission of the SMS message, the mobile station unassigns the digital traffic channel and terminates the procedure. The Examiner will appreciate that Willhof requires the call to be set up before the SMS message is transmitted.

In contrast, claim 1 includes the step of “terminating the setting up of the call channel once the user message has been communicated.” It is the *setting up* of the call channel that is terminated. The call channel itself is not used to transmit the user message. In order for Willhof to successfully anticipate the present development, Willhof would need to show something similar to the transmission of the SMS message *within* the Origination message or some other signaling message. This is not taught by Willhof. As such, claim 1 is patentably distinct from Willhof, and Applicant respectfully requests the Examiner to withdraw the rejection.

Furthermore, independent claim 1 requires:

placing a user message in a spare field of a
signaling message for setting up the call
channel

The Examiner asserts that this claim limitation is met by the teachings in the abstract of the specification and at col. 5, lines 55-65 of Willhof. However, the cited portions of Willhof

show only that a telesevice origination request is transmitted from the mobile station to the network using a reverse digital traffic channel. This request specifies a reverse digital traffic channel be assigned to the mobile station. Once this channel is assigned, Willhof transmits a stored SMS message, *over the assigned reverse digital traffic channel*, to a SMS center that is coupled to the network. Willhof, thus, does not teach that a message is placed in a spare field of a *signaling message*, as required by claim 1. Rather, Willhof sends and receives the SMS message over an *already assigned* digital traffic channel.

In other words, Willhof merely teaches what is already known before the invention disclosed in the present specification. Prior to the present invention, a short message was transmitted by 1) establishing a communication link (or setting up a call) between the caller and a called party; 2) once the communication link has been established, transmitting the short message through the link; and 3) once the short message is sent, terminating the communications link (or clear down the call). This process is the process performed in Willhof. By contrast, the present invention seeks to send the SMS message during step 1. To establish a communication link, first a request is sent during a signaling phase in order to request that a communications channel be assigned. As part of this signaling phase (i.e. as part of the initial request), the SMS message is sent. This feature, as recited in claim 1, is not taught or suggested by Willhof. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

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Independent claims 8 and 10 are patentably distinct over Willhof for substantially similar reasons to those noted above for independent claim 1. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of claims 8 and 10 as well.

Moreover, since all other claims ultimately depend on these claims, Applicant respectfully requests that the Examiner find that the dependent claims also patentably distinguish over the Willhof reference.

Claim rejections -- 35 U.S.C. § 103

The Examiner rejected claims 1, 2, 8, 10, and 11 under 35 U.S.C. § 103 as being unpatentable over Lahtinen in view of Perinpanathan. The Examiner rejected claims 4-7, 9, and 13-16 under 35 U.S.C. § 103 as being unpatentable over Lahtinen in view of Perinpanathan in further view of Willhof. Applicant respectfully traverses this rejection, first with respect to independent claim 1, in view of its requirement for:

terminating the setting up of the call
channel once the user message has been
communicated

In making this rejection, the Examiner asserted that Perinpanathan meets this requirement by its teachings at col. 2, lines 15-67.

Perinpanathan shows the call signaling necessary to effect a redirection of a call to a c/o address. A host sends a call setup request. A call redirector application sends a reply back indicating a c/o address. The call host then sends a call setup request to the foreign host at the

c/o address, and the foreign host sends a call setup reply, thereby establishing a link (i.e. a traffic channel) between the host and the foreign host. Each request and reply contains only the addressing information necessary to establish a link between the calling host and the foreign host. No user messages are sent; rather all communication at this point involves the addressing necessary to set up a call channel. While Perinpanathan does show terminating the setting up of a call channel, it does not show terminating the setting up of a call channel “once the user message has been communicated.” In Perinpanathan, no user messages are communicated.

As acknowledged by the Examiner, Lahtinen also does not teach the limitation of “terminating the setting up of the call channel once a reply to the user message has been received” as required in independent claim 1.

Lastly, as noted in the prior section, Willhof also fails to teach the limitation of “terminating the setting up of the call channel once a reply to the user message has been received” as presented in claim 1.

Furthermore, independent claim 1 requires:

placing a user message in a spare field of a
signaling message for setting up the call
channel

The Examiner asserts that this claim limitation is met in the abstract and Fig. 3 of Lahtinen. The cited portions of Lahtinen merely make use of short message service technology to enable communication between terminal units. Useful information (i.e. information that

would be necessary for an unattended reply to an incoming message) is stored in memory of the terminal unit, and when a call is received by the terminal unit, this information is automatically sent via a short message. In order to send this short message, a communication link (i.e. channel) must be assigned, and once assigned, the message is sent. Thereafter, the channel is terminated. Again, the message is sent after a channel is assigned. Lahtinen thus does not disclose placing a message in a spare field of a signaling message for setting up the call, as required by the claim limitation.

Perinpanathan also does not teach or suggest the required claim limitation. While Perinpanathan does show a call setup request from a calling host, Perinpanathan does not show placing a user message in a spare field of a signaling message for setting up a call. Regarding Fig. 7 of Perinpanathan, Applicant refers the Examiner the description of the figure at col. 12, line 63 to col. 13, line 3. At these lines, Perinpanathan teaches that the CH initiates a call set-up request directly to the callee's c/o address; the setup signaling steps required are completed; and *after this*, the conventional additional steps of negotiation and medial channel establishment are performed *eventually leading to* a media stream connections such as a voice communication, etc. This passage clearly shows that the channel is set up before any message is sent. Thus, Perinpanathan also does not teach or suggest placing a message in a spare field of a signaling message for setting up the call, as required by the claim limitation.

Lastly, as noted in the prior section, Willhof also fails to teach the limitation of placing a message in a spare field of a signaling message for setting up the call, as required by the claim limitation.

None of the three applied references teaches or suggests either of the claim limitation requirements discussed above. Even taken together, for what they would have meant as a whole to the person of ordinary skill, Applicant finds in the combined teachings no suggestion that could reasonably be interpreted as teaching the above-identified requirements of independent claim 1. The person of ordinary skill would not have (and could not have) combined Lahtinen, Perinpanathan, and Willhof in the manner suggested by the Examiner to achieve the subject matter of independent claim 1. Further, untaught modifications would have been necessary. Applicant therefore respectfully requests the Examiner to withdraw this rejection of independent claim 1 and its dependent claims.

Independent claims 8 and 10 are patentably distinct for reasons analogous to those noted above for independent claim 1. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of claims 8 and 10, as well as their respective dependent claims.

Moreover, there is no motivation to combine Lahtinen and Perinpanathan. Perinpanathan is concerned with offering users of multimedia communication call redirection features similar to those which are available to normal telephone subscribers. In other words, Perinpanathan desires to make newer, mobile communication, more like traditional methods of telephone communication.

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In contrast, Lahtinen is concerned with exploiting the division between digital signal channels and audio communication channels. Lahtinen uses the simultaneous availability of digital channels and audio channels to communicate information over the digital channel while the audio channel is being used. In other words, Lahtinen seeks to exploit the newest features of mobile communications systems in order to move beyond the limitations of traditional communication systems. Thus, one skilled in the art would not look to Perinpanathan to solve the problems present in Lahtinen, and vice versa.

Conclusion and request for interview

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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Respectfully submitted,



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